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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,558

12/14/2006

Horst Lange

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,558	<b>Applicant(s)</b> LANGE ET AL.	
	<b>Examiner</b> MARC S. ZIMMER	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2, 15, 16 and 37-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-42, 44, 46, 47, 49, 50, 52, 56-59, 61, 62, 65 and 66 is/are allowed.
- 6) ☒ Claim(s) 37, 45, 48, 51, 53-55, 60, 63 and 64 is/are rejected.
- 7) ☒ Claim(s) 2, 15, 16, 43 and 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Prior to this communication, the Examiner and Applicants' representative had engaged in some discussions about placement of the claims in proper condition for allowance. Among the observations made by the Examiner included (i) claims 2, 15, and 16 were now dependent from cancelled claims, (ii) while claim 38 was allowable in that instance where the polymer contained group (II), it was believed that a document first cited by the ISA, DE 100 03 322 would represent a foundation for holding at least this claim as unpatentable under 35 USC 103, and (iii) claim 43 was not regarded as being further limiting of claim 39.

Applicant inquired as to whether or not claims 2, 15, and 16 would be allowable if rewritten and independent form. It was indicated that claims 15 and 16 would be allowable, whereas claim 2 would have much the same scope as claim 38 and, hence, would be unpatentable. (The entire dialogue began with the Examiner informing Applicant that claim 38 could not be deemed patentable over DE 100 03 322 where a moiety of formula (I) was present.) However, upon reconsideration of this reference, it has been decided that it does not fairly teach the invention of either claim 32 or 38 because, in order to satisfy the their limitations, too much "picking and choosing" from the prior art would be required. In particular, one aspect of the prior art polysiloxane is that it contain a group of the formula  $-Q-NH-C(O)-NHCN$  where, in one of numerous embodiments, "Q" connotes a uretdione group. Separately, the polymer may optionally contain other units "A" and, in one instance, "A" symbolizes an amine group. However, there is nothing directing the reader to prepare a siloxane polymer that simultaneously contains both of these.

In his previous correspondence, the Examiner had indicated claims original claims 14, 17, and 19 contained allowable subject matter. Consequently, Applicant re-wrote these in independent form as claims 37, 38, and 39 and composed new claims mirroring the subject matter of the original claims dependent therefrom thus obviating not only the prior art rejections over *Hierstetter* and *Westall*, but also the non-statutory double-patenting rejections. However, the Examiner had not explained how these claims were allowable over the other reference, DE 100 36 533 cited by the ISA as being especially germane to the claims and, in fact, upon reviewing this document again, it appears that it does indeed anticipate at least claim 37. The Examiner sincerely regrets that Applicant had not been afforded the opportunity to respond to this matter earlier.

Lange et al., U.S. Patent # 7,041,767, which evolved from PCT/EP01/08695 (published as WO 02/10259), appears to provide a strongly overlapping disclosure to that DE 100 36 533. Because it is available in the English language, it will be used as a faithful translation of the WIPO document and the latter will be used as the foundation for rejection.

### ***Claim Objections***

Claim 55 is objected to because the substituents R<sup>3</sup> are not defined and it cannot be presumed that they have the same meaning as in claim 53 insofar as claim 55 is directly dependent from claim 37, and not claim 53.

Claim 43 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37, 45, 48, 51, 53-55, 60, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lange et al. WO 02/10259. To the extent that it evolved from a National stage application of the aforementioned international disclosure, U.S. Patent 7,041,767 is believed to have an identical disclosure and is used as a faithful translation of the WIPO document into the English language. All citation of teaching location will be those for the U.S. publication..

Lange discloses the preparation of a polysiloxane that, like those of the instant invention contain both amino/ammonium groups and also alkoxysilyl groups. See, in particular, formula (II) spanning columns 3 and 4 where Z<sup>1</sup> connotes an alkoxy radical (column 4, line 63). Moreover, the variables "m" and "s" may both be greater than one in which case there would be two -[Q-V]- units as is stipulated by claim 37. In formula (II), all the units "V" contain a polyorganosiloxane radical.

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As in the instant application, it is contemplated that the polymer(s) of the prior art may be employed as softeners in detergent compositions and, of course, these detergents are formulated as emulsions thus claim 64 is also satisfied.

***Allowable Subject Matter***

Claims 38-42, 44, 46-47, 49-50, 52, 56-59, 61-62, and 65-66 are allowable. In formula (II) of *Lange et al.*, the alkoxysilyl group would only be bonded to the polymer backbone via an oxygen atom. Also the diamines used in the preparation of the prior art polymers would not provide the units Q of claim 39.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 21, 2010

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796